



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/549,445	04/14/2000	Becki Speakman	70015060.02	8917

7590

07/02/2002

Jennifer H Hammond  
Sonnenschein Nath & Rosenthal  
4520 Main Street  
Suite 1100  
Kansas City, MO 64111

EXAMINER

MOHAMEDULLA, SALEHA R

ART UNIT PAPER NUMBER

1756

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/549,445

Applicant(s)

SPEAKMAN, BECKI

Examiner

Saleha R. Mohamedulla

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>Z</u> . | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 1-10 are pending. Claim 10 is withdrawn from consideration as being drawn to a non-elected invention. The 35 U.S.C. 112, second paragraph rejection of claims 1-5 and the objection to claim 6 are withdrawn in view of Applicant's amendments and remarks. The 35 U.S.C. 102 rejection based on Ogorzalek is withdrawn in view of Applicant's amendment to the claims. The amendment to the claim is not new matter and is supported at page 4, lines 10-15.

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 35, 40, 65 and 80. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 12 and 14. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1756

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US# 5,722,120 to Bindschatel et al.

Bindschatel teaches a pre-stamped adherent cover for door hinges. The adherent on the perimeter of an inner surface holds the cover in position while the door is being coated (col. 3, lines 23-25). Therefore, Bindschatel teaches a mask with an adhesive disposed on an inner surface. After the coating has dried, the cover can be peeled off easily and will leave no residue (col. 3, lines 25-30). Therefore, Bindschatel teaches that the backing is removably affixed to the mask at the inner surface and that the mask is adapted to be removably attached to the working surface at the inner surface. In one embodiment, the cover would be provided on a roll, as shown in Figure 3. The adherent cover can be peeled off the backing material 10 and applied to a door hinge quickly and easily (col. 3, lines 30-40). The roll would contain six hundred adherent covers, enough for one hundred doors. Therefore, Bindschatel teaches a plurality of designs formed in the mask. Because there are enough covers for one hundred doors, an entire door can be covered without having to remove the apparatus. Therefore, Bindschatel teaches that the apparatus is selectively dispensable to continuously cover the entire portion of the working surface (door) where the image is to be transferred such that the apparatus does not have to be repeatedly applied after each use to achieve the image transfer along the working surface. Figure 3 shows that the apparatus is a roll and that the designs repeat along a portion of the mask. Because there are six hundred designs, the designs repeat. The designs are precut designs,

Art Unit: 1756

intended to be spray coated (col. 3, lines 20-30). Therefore, the covers form a positive image.

The designs are formed in the interior portion of the mask, as shown in Figure 3.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US# 5,460,087 to Ogorzalek.

Ogorzalek teaches a stencil template fabricated from a closed cell foam with a stiff backing. The template has one smooth surface and a contact surface with a temporary stick mastic (col. 1, lines 55-60). The contact surface is allowed to adapt to a textured surface while the mastic provides a sealing that prevents paint from migrating under the template when applied to a surface (col. 1, lines 60-64). The mastic that forms the contact surface will repeatedly adhere to a structural surface to which paint is to be applied (col. 2, lines 23-25). Figure 4 shows the stencil. The stencil template 14 is fabricated from a closed cell foam material with a smooth top surface 50, a bottom contact surface 52 coated with an adhesive for repeatedly adhering the template to a wall surface 48 of a structure 36 as shown in Figure 5 (col. 3, lines 26-33). Claim 1 of Ogorzalek recites that the template has cut-outs through which paint is applied to a surface to which the template is adhered. Figures 1, 2 and 5 show various designs made by the cut-outs.

Art Unit: 1756

Ogorzalek also teaches that a protective, peel-off paper may be applied to the removable-type adhesive side of the stencil (col. 4, lines 27-31). Therefore, Ogorzalek teaches a mask (stencil template) having an outer surface (smooth surface) and an inner surface (contact surface). The inner surface has an adhesive disposed thereon (mastic) and a backing removably affixed to the mask at the inner surface (protective, peel-off paper). Ogorzalek also teaches a plurality of designs formed in the mask by the cut-outs. Ogorzalek teaches that the templates have die-cut and feature designs that can be repeated by repeatedly applying and moving the template along the length of the intended ornamentation (col. 2, lines 4-9). Therefore, Ogorzalek also teaches that the template is adapted to be removably attached to a surface at the inner surface (contact surface). Because the template can be repeatedly applied and moved, the template is selectively dispensable to continuously cover a portion of the surface. As shown in Figure 1, stencil 14 has a plurality of designs formed within an interior portion of the mask. These designs are cut-out portions, therefore, when paint is applied a positive image is formed.

Ogorzalek does not teach that the apparatus is selectively dispensable to continuously cover the entire portion of the working surface such that the apparatus does not have to be repeatedly applied after each use to achieve image transfer along the working surface.

Ogorzalek teaches, for instance in Figure 5, that the stencil template is repeatedly applied to form a border along a window. However, "working surface" as recited in claim 1 can be interpreted to be only a portion of a particular surface, i.e., one of ordinary skill in the art would use the stencil to pattern a surface that may be the length of the stencil, for example, a small portion to accent the window design. One of ordinary skill in the art would realize that if the

Art Unit: 1756

working surface were the length of the stencil that the stencil does not have to be repeatedly applied after each use to achieve image transfer along the working surface.

5. Claims 2 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US# 5,460,087 to Ogorzalek as applied to claim 1 above, and further in view of US# 6,312,872 to Murphy et al.

Ogorzalek teaches or suggests the limitations discussed above in paragraph 4, but does not teach or suggest that a plurality of designs repeat along a portion of the mask, or that designs are formed along an outer perimeter of the mask. Ogorzalek also does not teach that the apparatus is a roll. Murphy teaches a relief image printing plate. Murphy teaches preparing composite printing elements without the need for individual registration of relief image elements and without the need for compensating for elongation due to cylindrical mounting (col. 2, lines 20-25). In one embodiment, Murphy teaches that the printing plate may be cylindrical as shown in Figure 6 (col. 3, line 65 – col. 4, line 10). Therefore, Murphy teaches that the printing plate may be a roll. Because Murphy teaches that the printing element comprises relief elements, Murphy teaches that a negative image will be transferred to a surface. Figures 9 and 14 show exemplary designs on the printing plate. These designs are relief elements. Figure 14 shows a repeating pattern on the left and right sides of the cylinder. Figure 9 shows a repeating pattern of circles. Therefore, Murphy teaches that a plurality of designs repeat along a portion of the mask. Murphy does not specifically teach forming designs along an outer perimeter, however, one of ordinary skill in the art would realize that Murphy envisions embodiments where designs are placed in the outer perimeter because Murphy teaches that individual registration of the designs

Art Unit: 1756

or elements is not needed when making the plate (col. 2, lines 20-25). Therefore, the plate may comprise designs placed in the outer perimeter.

The references are analogous art as they are drawn to transferring images by applying masks to a surface; the printing plate of Murphy is used to print a variety of substrate (col. 1, lines 15-20) and the stencil of Ogorzalek is used to print ornamental structures (col. 1, lines 50-55). It would have been obvious to one of ordinary skill in the art to use the pattern and cylinder of Murphy with the mask of Ogorzalek as Murphy teaches that the printing element can be of various shapes, such as a sheet or a cylinder (col. 3, lines 60-67). Because Murphy teaches the shape of the printing element is a design choice, one of ordinary skill in the art would expect that the printing element of Ogorzalek, the stencil, could be made into different shapes.

6. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US# 5,722,120 to Bindschatel et al. in view of US# 6,312,872 to Murphy et al.

Bindschatel teaches the limitation discussed above in paragraph 3: Bindschatel does not teach that the designs are formed along an outer perimeter of the mask and transfer a negative image. Murphy teaches a relief image printing plate. Murphy teaches preparing composite printing elements without the need for individual registration of relief image elements and without the need for compensating for elongation due to cylindrical mounting (col. 2, lines 20-25). In one embodiment, Murphy teaches that the printing plate may be a roll as shown in Figure 6 (col. 3, line 65 – col. 4, line 10). Because Murphy teaches that the printing element comprises relief elements, Murphy teaches that a negative image will be transferred to a surface. Figures 9 and 14 show exemplary designs on the printing plate. These designs are relief elements.



Art Unit: 1756

Murphy does not specifically teach forming designs along an outer perimeter, however, one of ordinary skill in the art would realize that Murphy envisions embodiments where designs are placed in the outer perimeter because Murphy teaches that individual registration of the designs or elements is not needed when making the plate (col. 2, lines 20-25). Therefore, the plate may comprise designs placed in the outer perimeter.

The references are analogous art as they are drawn to transferring images by applying masks to a surface; the printing plate of Murphy is used to print a variety of substrate (col. 1, lines 15-20) and the cover of Bindschatel is used to print doors. It would have been obvious to one of ordinary skill in the art to use the relief elements of Murphy with the mask of Bindschatel as Murphy teaches that the relief elements are used to print a variety of surfaces (col. 1, lines 15-20). One of ordinary skill in the art would use negative image relief elements instead of positive image elements as both elements can be used to imprint a substrate.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1 and 3 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments with respect to the Murphy referenced have been fully considered but they are not persuasive. Applicant argues that in Murphy, the image is transferred onto the printing element and therefore, the printing element cannot be analogized to the mask. While Murphy teaches a method of making a printing element, Murphy also teaches that printing plates are used in flexographic and letterpress processes for printing patterns onto a variety of surfaces (col. 1, lines 15-20). Therefore, Murphy teaches using the printing element to print surfaces. The figures discussed in paragraph 5 and

Art Unit: 1756

relied upon to show the features of the printing element show the manufactured printing element and not the process of making the element. Applicant argues that Murphy does not teach that the printing element has precut designs, however, in figures 13 and 14, Murphy teaches that the element has precut designs. Therefore, Applicant's arguments are not persuasive.

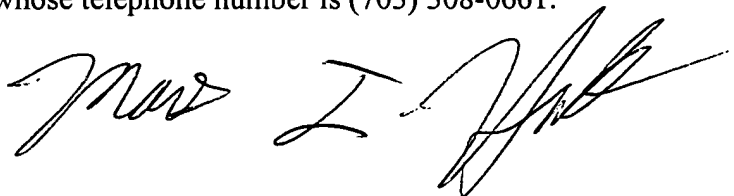
### *Conclusion*

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Saleha Mohamedulla whose telephone number is (703) 308-1260. The Examiner can normally be reached Monday-Friday, from 8:00 AM to 4:30 PM. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mark Huff, can be reached on (703) 308-2464. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310. The After Final fax phone number is (703) 872-9311. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

srm

SRM

June 30, 2002



MARK F. HUFF  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700